REMARKS

Summary of the Office Action

Claims 23-24 stand objected to at page 2 of the Office Action.

Claims 1 and 21-22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Publication No. 2001/0030827 A1 to Morohashi (hereinafter "Morohashi") further considered with either U.S. Patent No. 6,915,377 to Hitotsui (hereinafter "Hitotsui") or U.S. Patent No. 6,477,313 to Itoi (hereinafter "Itoi") and all further considered with U.S. Patent No. 5,987,417 to Heo (hereinafter "Heo").

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,362,928 to Hamai et al. (hereinafter "Hamai") further considered with either Hitotsui or Itoi.

Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of U.S. Patent No. 5,619,483 to Yokota et al. (hereinafter "Yokota").

Claims 8-16 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of Heo.

Claims 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of U.S. Patent No. 6,226,441 to Hartung et al. (hereinafter "Hartung").

Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of allegedly "well known word processing nomenclature and the Dewey-Decimal system."

Summary of the Response to the Office Action

Verified English-language translations of each of the instant application's priority documents are being submitted herewith. Claims 1-24 remain pending for consideration.

Rejections under 35 U.S.C. § 102(e) and 103(a)

Claims 1 and 21-22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Morohashi further considered with either Hitotsui or Itoi and all further considered with Heo. Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi. Claims 4-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of Yokota. Claims 8-16 and 21-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of Heo. Claims 17-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of Hartung. Claims 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi and further in view of allegedly "well known word processing nomenclature and the Dewey-Decimal system."

With regard to independent claim 1, which was rejected under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Morohashi further considered with either Hitotsui or Itoi and all further considered with Heo, Applicants respectfully submit that Morohashi and Hitotsui should not be considered as prior art in the present application under any subjection of 35 U.S.C. § 102. On August 5, 2003, Applicants

filed a Claim for Priority and a Certified Copy of each of Japanese Patent Application Nos. 2000-0357769, 2000-357772, and 2000-357773, which were each filed in Japan on November 24, 2000. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of each of these Japanese Patent Applications. The U.S. filing date under 35 U.S.C. § 102(e) of Morohashi is January 30, 2001, which is after the priority date to which this application is entitled. Accordingly, Applicants respectfully submit that Morohashi should not be considered as prior art in the present application under any subjection of 35 U.S.C. § 102. Similarly, the U.S. filing date under 35 U.S.C. § 102(e) of Hitotsui is July 17, 2001, which is also after the priority date to which this application is entitled. Accordingly, Applicants respectfully submit that Hitotsui should also not be considered as prior art in the present application under any subjection of 35 U.S.C. § 102. As a result, Applicants respectfully request withdrawal of all rejections under 35 U.S.C. §§ 102(a) and 103(a) that apply either the Morohashi and Hitotsui references.

Independent claim 1 further stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with either Hitotsui or Itoi. As noted above, the secondary reference to Hitotsui no longer qualifies as prior art against the instant application. Withdrawal of this portion of the rejection is respectfully requested.

With regard to the remaining rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Hamai further considered with Itoi, Applicants respectfully traverse the rejection for at least the following reasons.

The Office Action applies Hamai as allegedly teaching all of the features of independent claim 1 except that Itoi is applied for its alleged teaching of what the Office Action refers to as

"the additional ability of re-recording appropriate management information (group designation) as a result of user's instruction in order to either a move or merge of the information so selected into appropriately designated groups." In particular, the Office Action refers to col. 4, line 52+ of Itoi for its teaching of a "merge information mode - GMM."

Applicants respectfully submit that the GOP Merge Information Mode (GMM) discussed at col. 4, lines 52+ of Itoi involves a mode for a control ECC block which is utilized to "change the playback sequence in GOP units, for example, when video data in different positions on a disc must be merged for playback." Accordingly, it is clear that Itoi's disclosed GMM mode groups together particular data that has already been recorded at various positions on a disc instead of providing a grouping instruction during recording of the information to be grouped onto the disc, as described in independent claim 1.

As discussed in the response previously filed in this application on May 23, 2005, and as also discussed throughout the specification of the instant application, with the continuing increases in the recording capacity of recent recording medium formats, and also as various data compression schemes allow for larger amounts of data to be recorded on a recording medium, it becomes more and more complicated for a user to manually assign each of the pieces being recorded onto the medium to a particular group during the recording process. See, for example, page 3, lines 2-6 of the instant application's specification.

Embodiments of the recording apparatus disclosed in the instant application greatly simplify this problem because the user does not need to manually perform grouping operations himself when recording tracks onto the medium. Instead, the grouping processing is performed by the system controller 51, instead of by the user. In other words, the grouping processing is

automatically performed when a change in track recording is detected. See, for example, page 34, lines 17-26 and the final sentence of the Abstract. See also page 19, line 12 through page 20, line 9; page 20, line 23 through page 21, line 4; page 22, lines 5-11, page 23, lines 12-23; and page 25, lines 9-22, for example.

In this regard, independent claim 1 of the instant application describes "a detection device for giving a grouping instruction to said information attaching and generating device at the time when the inputting operation relating to track recording is detected during recording of information."

It is clear that the GMM mode discussed in Itoi does not assign such a grouping instruction at a time when an inputting operation relating to track recording is detected during the recording of the information to be grouped onto the disc. Instead, Itoi teaches that this GMM mode is utilized to change the playback sequence of GOP units, for example, when video data already recorded at different positions on a disc are desired to be merged for playback.

Even further, the disclosure of Itoi does not address the above-discussed problem of simplifying the grouping process for a user in the situation of a recording medium having a large amount of data. In particular, Itoi does not discuss obviating the need for a user to manually assign the grouping instructions in connection with its disclosed GMM mode. Instead, Itoi simply discloses that a user can choose to group certain pieces of already recorded data together as a group if the user so desires. The user still needs to manually assign the grouping instruction to each individual piece of recorded data, respectively, that are to be included in any particular group. Accordingly, it is clear that such a grouping arrangement is similar to that discussed in the Background portion of the instant application's specification.

Thus, Applicants respectfully submit, for at least the foregoing reasons, that the GMM mode disclosed by Itoi is significantly different from the automatic grouping instruction that occurs during the recording of information, as described in the information recording apparatus combination of independent claim 1. Accordingly, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. § 103(a) over Hamai in view of Itoi should be withdrawn because neither of these references, whether taken singly or combined, teach or suggest each feature of independent claim 1, as discussed in detail above.

Even further, Applicants respectfully submit that one having ordinary skill in the art would not be motivated to make the Office Action's asserted combination of features from Hamai and Itoi for at least the following reasons. In particular, Hamai is directed to a magnetic tape arrangement while Itoi is directed to an optical disc arrangement. Applicants respectfully submit that a magnetic tape arrangement is significantly different from an optical disc arrangement. For example, Fig. 24 of Hamai shows a magnetic tape arrangement in which recorded data is physically recorded in sequence. Fig. 11 of Itoi, on the other hand, shows an optical disc arrangement in which recorded data is not physically recorded in sequence.

Applicants respectfully submit that the different physical structures of these respective types of recording media result in each of them having their own types of functionalities. In other words, the structure and arrangement of tracks on an optical disc, together with particular management information on the disc, allows for such functionality as direct access of particular tracks or Itoi's GOP Merge Information Mode (GMM) as applied by the Office Action. However, the significantly different format of how data is recorded on a magnetic tape would not allow for such direct access, merging, or grouping functionality to be achieved.

Finally, another difference that results between the magnetic tape arrangement of Hamai and the optical disc arrangement of Itoi is evidenced by the Office Action's apparent concession, at page 6, in the next to last paragraph, that the "tape System" of Hamai does not include track numbering, as described in independent claim 1. However, the Office Action states that the Examiner "interprets the track numbering to be inherently present."

Applicants traverse such an assertion because, as discussed above, information on a tape medium is recorded sequentially and thus "track numbering" is not required in such an arrangement. Hamai's lack of any discussion of such "track numbering" is consistent with this understanding. In an optical disc arrangement, on the other hand, such track numbering is particularly important because information is not necessarily recorded in a sequential manner on the disc. In addition, track numbering is required in order to achieve such optical disc functionality as direct access and group management of particular recorded tracks on the disc, as previously discussed.

Even further, Hamai explicitly discourages the use of alternative types of recording media, such as a "record medium, a hard disk, [and] an optical disk" and goes on to assert that "the magnetic tape is more practical and superior in storage capacity, changeability, and price ... compared with other record media." See col. 1, lines 16-23 of Hamai. Accordingly, Applicants respectfully submit that Hamai clearly teaches away from the combination asserted by the Office Action.

Accordingly, Applicants respectfully assert that the rejection of claim 1 under 35 U.S.C. § 103(a) over Hamai in view of Itoi should be withdrawn because neither of these references, whether taken singly or combined, teach or suggest each feature of independent claim 1, as

discussed in detail above. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Moreover, Applicants traverse the Office Action's combination of Hamai and Itoi for the reasons set forth above. Furthermore, Applicant respectfully asserts that the dependent claims are allowable at least because of their dependence from independent claim 1, and the reasons set forth above. Also, Applicants respectfully submit that the additionally applied references of Yokota, Heo, Hartung, and the Dewey-Decimal system, do not cure the deficiencies discussed above with regard to Hamai and Itoi.

Objection to Claims 23 and 24

Claims 23-24 stand objected to at page 2 of the Office Action. This objection is respectfully traversed for at least the following reasons. The Examiner asserts that he "cannot readily map the newly introduced functional limitation with the specification as originally filed." Claim 23 explains that the registration device of claim 22 "changes said read-out information when said registration device determines that the same information as said read-out information is already registered, and registers said read-out information as the group information after changing said read-out information." Claim 24 goes on to explain that the "registration device performs registration by adding a change that a sub-number is given to said read-out information." Applicants respectfully submit that these features are fully supported by the disclosure of the instant application, as originally filed. The change to claim 23 was implemented to clarify that the registration device changes the read-out information. See, for

example, the discussion in the instant application's specification at page 33, line 8 to page 35, line 8 for complete support of the subject matter of claims 23 and 24. See also Fig. 9 of the instant application as providing additional support for the subject matter of these claims. Accordingly, withdrawal of the objection to claims 23 and 24 are respectfully requested.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request withdrawal of all outstanding objections and rejection, and request the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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